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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,753	01/30/2002	Toshifumi Komatsu	970.0098US01	6971
57557	7590	10/30/2006	EXAMINER	
PAULY, DEVRIES SMITH & DEFFNER, L.L.C.			GILLIAM, BARBARA LEE	
P.O. BOX 2960			ART UNIT	
MINNEAPOLIS, MN 55402-2960			PAPER NUMBER	

1752

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/060,753

Applicant(s)

KOMATSU ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 9, 16, 17, 19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-6, 9, 16-17, 19, 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed August 17, 2006 has been entered and fully considered.
2. Claims 1-3, 5-6, 9, 16-17, 19, 21-25 are pending.
3. The rejections of claim 1 under 35 USC 112, 1<sup>st</sup> paragraph and of claim 16 under 35 USC 112, 2<sup>nd</sup> paragraph are withdrawn in light of the amendments.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 was amended to include the following: "wherein each photosensitive layer contains a pressure sensitive adhesive composition, a polymeric photosensitive resin, an polyvinyl acetate" however there is insufficient support in the specification for the added limitation. A pressure sensitive adhesive is only discussed in conjunction with the tacky photosensitive layer which provides adhesion to the substrate. See page 15, lines 5-9. In both exemplified first tacky photosensitive layers, Example

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Photosensitive Tacky Layer I and Example Photosensitive Tacky Layer II, a pressure sensitive adhesive material is contained therein. In contrast the exemplified second substantially less tacky photosensitive layers, Example Photosensitive "Hard" Layer I and Example Photosensitive "Hard" Layer II, do not contain said pressure sensitive adhesive. See pages 15-18.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-6, 9, 17, 19, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOOGMARTENS et al. (US 5,922,506) in view of ASANO et al. (US 6,106,992).

a. In US 5,922,506, HOOGMARTENS et al. teach a negative-working photosensitive imaging element comprising on a hydrophilic surface of a support in the order given, a hydrophobic photopolymerization layer contiguous to the hydrophilic surface of the support and comprising at least part of at least one unsaturated compound, a hydrophobic photosensitive layer contiguous to the polymerizable layer and comprising at least part of at least one hydrophobic thermoplastic polymer and at least one photoinitiator and optionally a receptor layer (claim 1). The thermoplastic

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polymers are used in an amount of at least 50% by weight and examples thereof include polyvinyl acetate (column 6, lines 50-51; column 8, lines 47-54). Agents to improve the wetting an/or adjust the adhesion of the photopolymerizable composition may be added (column 7, lines 37-43 & column 8, lines 42-46). The support can comprise a polyethylene layer (column 10, lines 44-54) and comprise one or more hydrophilic layers such as layers of hardened polyvinyl alcohol (column 10, lines 25-36). The support meets the present limitations for the carrier layer and the hydrophilic layer coated thereon meets the present limitations for the membrane layer. The imaging element of Hoogmartens et al. may comprise a temporary protective layer on top of the photosensitive layer, which can comprise polyvinyl alcohol. The temporary layer can be removed before or after the photoexposure step (column 10, lines 62-67). Preferably the imaging element either comprises a receptor layer or a transfer layer and a receptor layer wherein the transfer layer is between the photosensitive composition and the receptor layer. Suitable receptor layers include transparent organic resins (column 11, lines 1-25). The temporary protective layer and the receptor layer meet the present limitations for the ink-receptive, radiation transmissive layer. Additionally the temporary protective layer meets the present limitations for the printable cover sheet.

Hoogmartens et al. do not teach organic or inorganic particles in the temporary protective layer or the receptor layer however, based on the teachings of ASANO et al. (column 14, lines 55-67 & column 21, lines 33-46) it would have been obvious to incorporate fillers such as calcium carbonate into either layer to reduce to cost and increase handleability. Preferably, the fillers are used in an amount of 10 to 500 parts

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by weight (col. 14, lines 64-67). The imaging element is then image-wise exposed to actinic radiation (HOOGMARTENS et al; column 13, line 46 – column 14, line 58).

### ***Response to Arguments***

8. Applicant's arguments filed August 17, 2006 have been fully considered but they are not persuasive. Applicant simply argued that nothing in the combination of HOOGMARTENS and ASANO teaches or makes obvious the photosensitive laminate structure of claim 1.

9. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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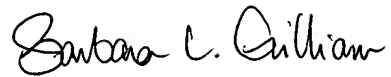
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in cursive script, reading "Barbara L. Gilliam".

Barbara L. Gilliam  
Primary Examiner  
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bg  
October 27, 2006